



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,336	12/14/1998	ERLAND WITTKOTTER	HPB-7	2766

7590 11/29/2002
DAVID M CARTER
CARTER & SCHNEDLER
PO BOX 2985
ASHEVILLE, NC 28802

EXAMINER

HUSEMAN, MARIANNE

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/202,336

Applicant(s)

WITTKOTTER, ERLAND

Examiner

M. Huseman

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/16/02 have been fully considered but they are not persuasive. Upon further consideration of Applicant's claim language; i.e., "...and a readability or usability of the produced document is dependent *on an online, or at least one temporary online, contact...*" (emphasis added), Blatter et al teach that the programs can be received from the internet, column 3, lines 42 - 49. The Examiner's interpretation is that retrieving the programs themselves via the internet reads on the limitation "...a readability or usability of the produced document is dependent on an online, or at least one temporary online, contact..."; i.e., it is necessary to receive the programs (documents) in order to read or use them. Therefore, the art rejection of the previous office action stands.

Applicant, please note, that the term "online" is not given to hold special meaning regarding the internet; i.e., two computers can be considered to be online with one another without being connected through the internet (e.g., LAN). Also, please note, that references disclosing receiving the decryption keys, necessary to decrypt encrypted programs, via the internet are cited in the US Form 892, attached herewith.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 3, 4, 6 – 11 and 13 - 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Blatter et al '873.

Regarding all of the above claims:

Blatter et al teach a data storage and decoding means, figure 1, such that Applicant's local computer system reads on element 25 and column 3, lines 44 - 49, Applicant's external data source reads on element 130, Applicant's local data storage means reads on elements 95, 90 and 105 and column 4, lines 61 – 64, Applicant's linking means reads on elements 115 and 110 and 70, Applicants' protection data reads on the encryption keys of smart card, element 130, Applicant's storing in a non-reconstructed form reads on the PIDs and column 4, lines 41 – 55 and Applicants' non-linearity of the data storage means reads on column 14, lines 41 – 49.

Regarding particularly claims 3 and 10:

Applicant's operational instructions read on column 5, lines 19 – 26.

Regarding claim 4:

Applicant's storage means reads on column 6, lines 34 – 43.

Regarding claims 6 and 17:

The language of Applicant's claim 6 reads on the smart card, element 130 and an inherent smart card reader (interface).

Regarding claims 7 and 13:

Applicant's identification and billing data read on Blatter et al's entitlement data of smart card, element 130.

Regarding claim 8:

Applicant's control module reads on element 125.

Regarding claim 9:

Applicant's step of ensuring reads on the encryption of the programs disclosed in Blatter et al.

Regarding claims 14 and 15:

Applicant's step of encoding reads on the keys of element 130, Applicant's step of transmitting reads on an inherent smart card reader/interface and Applicant's step of decoding reads on elements 115 and 33.

Regarding claim 16:

Applicant's plurality of document units reads on Blatter et al's plurality of video programs.

Regarding claim 18:

Applicant's data reads on column 3, lines 43 – 49 and column 9, lines 59 – 62.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blatter et al '873.

Blatter et al teach that their program (encrypted) contains gaps wherein CPSI (Condensed program specific information), used for mapping data, can be placed, columns 13 and 14, lines 34 – 42 and lines 7 – 20, respectively. This information is used in conjunction with the smart card to de-map the data stored in the storage devices. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to receive this information to fill the gaps via a smart card (as this claim is interpreted as performing by the Examiner) rather than by the system, element 25, of Blatter et al., e.g., if the smart card is a "store owned" smart card and all of the data of the videos (programs) received is certain to be arranged the same way.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spies et al, Yasukawa et al, Mages et al '825, Oshima et al each teach transmitting a decryption key, via the internet, from a provider (external data source).

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Huseman whose telephone number is 703-605-4277. The examiner can normally be reached on Monday - Friday, 6:30 AM - 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600


M. Huseman
Examiner
Art Unit 3621